

Theodore K. Stream, State Bar #138160

Email: Ted.Stream@streamkim.com

Mario H. Alfaro, State Bar #246420

Email: Mario.Alfaro@streamkim.com

STREAM KIM HICKS WRAGE & ALFARO, PC

3403 Tenth Street, Suite 700

Riverside, CA 92501

Telephone: (951) 783-9470

Facsimile: (951) 783-9475

Attorneys for Defendant, MINKA LIGHTING, INC.

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
EASTERN DIVISION**

VAXCEL INTERNATIONAL CO.,
LTD.,

Plaintiff,

vs.

MINKA LIGHTING, INC.

Defendant.

CASE NO.: 5:18-cv-02549-GW (SHKx)

**DEFENDANT MINKA LIGHTING
INC.'S ANSWER AND
COUNTERCLAIM TO PLAINTIFF
VAXCEL INTERNATIONAL CO.
LTD.'S COMPLAINT**

DEMAND FOR JURY TRIAL

Defendant Minka Lighting, Inc. ("Minka" or "Defendant") hereby answers the Complaint filed by Plaintiff Vaxcel International Co. Ltd. ("Vaxcel" or "Plaintiff"). Each numbered paragraph of the Answer corresponds to the same numbered paragraph of the Complaint.

PARTIES

1. Minka admits the allegations contained in Paragraph 1 of the Complaint.

2. Minka admits the allegations contained in Paragraph 2 of the Complaint.

1 3. Minka admits the allegations contained in Paragraph 3 of the
2 Complaint.

3 **JURISDICTION AND VENUE**

4 4. Minka admits the allegations contained in Paragraph 4 of the
5 Complaint.

6 5. Minka admits the allegations contained in Paragraph 5 of the
7 Complaint.

8 6. Minka admits that it regularly conducts business in the Central District
9 of California. Minka denies that it has committed any acts or omissions giving rise
10 to Plaintiff's claims in this or any other judicial district and the remaining allegations
11 contained in Paragraph 6 of the Complaint.

12 7. Minka denies the allegations contained in Paragraph 7 of the
13 Complaint.

14 8. Minka admits that this Court has personal jurisdiction over it. Minka
15 denies the remaining allegations contained in Paragraph 8 of the Complaint.

16 9. Minka admits that venue is proper in the Central District of California.
17 Minka denies the remaining allegations in Paragraph 9 of the Complaint.

18 **BACKGROUND**

19 10. Minka is without sufficient information to form a belief as to the
20 truthfulness of the allegations contained in Paragraph 10 of the Complaint, and
21 therefore denies them.

22 11. Minka is without sufficient information to form a belief as to the
23 truthfulness of the allegations contained in Paragraph 11 of the Complaint, and
24 therefore denies them.

25 12. Minka admits that United States Patent No. 10,117,313 ("the '313
26 Patent") issued on October 30, 2018. Minka denies the remainder of the allegations
27 contained in Paragraph 12 of the Complaint.

13. Minka is without sufficient information to form a belief as to the truthfulness of the allegations contained in Paragraph 13 of the Complaint, and therefore denies them.

14. Minka admits that it is not a licensee of Vaxcel and denies that it needs a license from Vaxcel. Minka denies the remainder of the allegations contained in Paragraph 14 of the Complaint.

COUNT I

PATENT INFRINGEMENT OF U.S. PATENT NO. 10,117,313

15. Minka repeats and realleges its answers to Paragraphs 1 through 14 of the Complaint as if fully set forth herein.

16. Minka admits that it manufactures, distributes, and markets its lighting products. Minka denies the remainder of the allegations contained in Paragraph 16 of the Complaint.

17. Minka admits that it sells lanterns or lamps with a motion detector exclusively to Home Depot and denies the remainder of the allegations contained in Paragraph 17 of the Complaint.

18. Minka denies the allegations contained in Paragraph 18 of the Complaint.

19. Minka denies the allegations contained in Paragraph 19 of the Complaint.

20. Minka denies the allegations contained in Paragraph 20 of the Complaint.

21. Minka admits that it imports, sells, and/or offers to sell the Port Oxford (Model No. 22211) and the McCarthy (Model No. 22411) lamps with a motion detector exclusively to Home Depot. Minka denies the remainder of the allegations contained in Paragraph 21 of the Complaint.

22. Minka denies the allegations contained in Paragraph 22 of the

1 Complaint.

2 23. Minka denies the allegations contained in Paragraph 23 of the
3 Complaint.

4 24. Minka denies the allegations contained in Paragraph 24 of the
5 Complaint.

6 25. Minka admits that the documents attached as Exhibit C and Exhibit D
7 to Plaintiff's Complaint contain the quoted language. Minka denies the remainder
8 of the allegations contained in Paragraph 25 of the Complaint.

9 26. Minka denies the allegations contained in Paragraph 26 of the
10 Complaint.

11 27. Minka denies the allegations contained in Paragraph 27 of the
12 Complaint.

13 28. Minka denies the allegations contained in Paragraph 28 of the
14 Complaint.

15 29. Minka denies the allegations contained in Paragraph 29 of the
16 Complaint.

17 30. Minka denies the allegations contained in Paragraph 30 of the
18 Complaint.

19 31. Minka denies the allegations contained in Paragraph 31 of the
20 Complaint.

21 32. Minka denies the allegations contained in Paragraph 32 of the
22 Complaint, and denies that Plaintiff is entitled to any relief requested in Paragraph
23 32, the Prayer for Relief, or anywhere else in the Complaint.

24 AFFIRMATIVE DEFENSES

25 1. Subject to and without waiver of the denials and responses contained in
26 its Answer, Minka alleges as follows as its affirmative defenses. In asserting these
27 defenses, Minka does not assume the burden of proof as to matters that, pursuant to

1 law, are Vaxcel's burden to prove.

2 **FIRST AFFIRMATIVE DEFENSE**

3 2. Minka has not infringed, willfully infringed, contributed to
4 infringement of, or actively induced others to infringe, and does not willfully or
5 otherwise infringe, contribute to infringement of, or actively induce others to
6 infringe any valid claim of the '313 Patent.

7 **SECOND AFFIRMATIVE DEFENSE**

8 3. The claims of the '313 Patent are invalid for failure to satisfy or comply
9 with 35 U.S.C. §§ 101, 102, 103, 112, and/or any other judicially created doctrines
10 such as the doctrine of obviousness-type double patenting.

11 **THIRD AFFIRMATIVE DEFENSE**

12 4. By reason of the prosecution of the application for the '313 Patent,
13 Plaintiff is estopped from construing the claimed inventions of the '313 Patent (or
14 any equivalent thereof) as applying to any product made, used, sold, and/or offered
15 for sale by Minka.

16 **FOURTH AFFIRMATIVE DEFENSE**

17 5. Plaintiff's claims in this action are barred under the equitable doctrines
18 of estoppel, laches, acquiescence, and/or unclean hands.

19 **FIFTH AFFIRMATIVE DEFENSE**

20 6. Plaintiff is not entitled to any damages or profits in this action for any
21 alleged infringement prior to filing this Complaint because Plaintiff failed to comply
22 with the marking requirements of 35 U.S.C. § 287(a).

23 **SIXTH AFFIRMATIVE DEFENSE**

24 7. Plaintiffs fail to state a proper claim for an exceptional case and/or
25 willful infringement. No acts by Minka give rise to an exceptional case under 35
26 U.S.C. § 285.

27 ///

SEVENTH AFFIRMATIVE DEFENSE

8. Minka reserves the right to assert any and all additional defenses and counterclaims that may be developed, whether through discovery, further investigation, and/or otherwise, including defenses or counterclaims of unenforceability.

COUNTERCLAIMS

Defendant and Counterclaim-Plaintiff Minka Lighting Inc. (“Minka”) for these counterclaims against Plaintiff and Counterclaim-Defendant Vaxcel International Co., Ltd. (“Vaxcel”), alleges as follows.

THE PARTIES

1. Minka is incorporated under the laws of the State of California, with its principal place of business at 1151 West Bradford Court, Corona, California 92882.

2. Vaxcel is, on information and belief, an Illinois corporation with its principal place of business located at 121 E. North Avenue, Carol Stream, Illinois 60188.

JURISDICTION AND VENUE

3. These Counterclaims are an action for declaratory judgment of patent non-infringement and/or patent invalidity pursuant to 28 U.S.C. §§ 2201 and 2202.

4. These Counterclaims arise under the laws of the United States, and this Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331 and 1338(a), as well as under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. The Court also has subject matter jurisdiction over this controversy under 28 U.S.C. § 1332 as the action is between citizens of different states and the amount in controversy in this action, exclusive of interest and costs, exceeds the sum of \$75,000.

5. This Court has personal jurisdiction over Vaxcel because Vaxcel filed the Complaint in this Court, alleging infringement of the ’313 Patent by Minka, and

1 because, on information and belief, Vaxcel conducts substantial business in this
2 District and has engaged in systematic and regular contact with this District.

3 6. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and
4 (c) because this Court has personal jurisdiction over Vaxcel and because a
5 substantial part of the events giving rise to Minka's declaratory judgment claims
6 occurred in this District. Minka is also Defendant and Counter-Plaintiff, and resides
7 in the Eastern Division of the Central District of California. Minka alleges that this
8 case should be dismissed or consolidated with Case Nos. 5:18-cv-01484 GW
9 (SHKx), styled *Vaxcel International Co., Ltd. v. Minka Lighting, Inc.*

10 BACKGROUND

11 7. Vaxcel alleges in the Complaint that United States Patent No.
12 10,117,313 (the "'313 Patent'") issued on October 30, 2018.

13 8. Vaxcel alleges in its Complaint that it is the assignee of the '313 Patent.

14 9. Vaxcel purports to be the owner of all right, title, and interest in the
15 '313 Patent.

16 10. On December 4, 2018, Vaxcel filed its Complaint in this Court alleging
17 Minka has infringed the '313 Patent by commercial manufacture, use, offer to sell,
18 sale, or importation of certain Minka products.

19 11. There is an actual, substantial and justiciable controversy between
20 Minka and Vaxcel relating to the non-infringement and/or invalidity of the '313
21 Patent.

22 COUNT I

23 NON-INFRINGEMENT OF THE '313 PATENT

24 12. Minka repeats and realleges and incorporates by reference all preceding
25 paragraphs of the Counterclaims as if fully set forth herein.

26 13. Minka has not, does not, and will not infringe any valid or enforceable
27 claim of the '313 Patent by the manufacture, use, offer to sell, sale, or importation

1 of any Minka products, including but not limited, to the Port Oxford (Model No.
2 22211) and the McCarthy (Model No. 22411) lamps with a motion detector (the
3 “Accused Products”).

4 14. The Accused Products have not infringed and do not infringe any claim
5 of the ’313 Patent, either directly or indirectly, literally or under the Doctrine of
6 Equivalents. More particularly, the Accused Products lack at least the exemplary
7 limitations of independent claims 1, 9, and 11 that call for “a cover[,] partially
8 covering the sensing unit; wherein . . . the at least one sensor at the first side of the
9 sensing unit is not blocked and is capable of performing sensing function when the
10 sensing unit is rotated to the first angle, [wherein] the at least one parameter adjusting
11 element at the second side of the sensing unit is exposed to being adjusted when the
12 sensing unit is rotated to the second angle.” Pursuant to the requirements of the
13 exemplary limitations in independent claims 1, 9, and 11, neither the alleged
14 “sensor” nor the alleged “parameter adjusting element” is covered by the cover in
15 either the alleged “first angle” or the alleged “second angle” positions for the
16 Accused Products.

17 15. Minka is entitled to a judicial declaration that it has not infringed, and
18 that the commercial manufacture, use, offer to sell, sale, or importation of any Minka
19 products will not infringe, any valid or enforceable claim of the ’313 Patent.

20 16. This is an exceptional case under 35 U.S.C. § 285 and Minka is entitled
21 to an award of its costs, expenses and reasonable attorneys’ fees.

22 **COUNT II**

23 **INVALIDITY OF THE ’313 PATENT**

24 17. Minka repeats and realleges and incorporates by reference all preceding
25 paragraphs of the Counterclaims as if fully set forth herein.

26 18. One or more claims of the ’313 Patent are invalid under 35 U.S.C. §§
27 101, 102, 103, 112 and/or any judicially created doctrines such as the doctrine of

1 obviousness-type double patenting.

2 19. One or more claims of the '313 Patent are invalid as obvious to a person
3 of ordinary skill in the art under 35 U.S.C. § 103 at least over U.S. Patent No.
4 7,473,899 or U.S. Patent 5,590,953 in view of other prior art.

5 20. This is an exceptional case under 35 U.S.C. § 285 and Minka is entitled
6 to an award of its costs, expenses and reasonable attorneys' fees.

7 PRAYER FOR RELIEF

8 WHEREFORE, Counter-Plaintiff Minka prays for a judgment against
9 Counter-Defendant Vaxcel as follows:

- 10 1. Dismissing the Complaint in its entirety with prejudice;
- 11 2. Entering judgment in favor of Minka;
- 12 3. A declaration that the manufacture, use, offer to sell, sale, or
13 importation of any accused Minka product has not, does not, and will not infringe
14 any valid or enforceable claim of the '313 Patent;
- 15 4. A declaration that the manufacture, use, offer to sell, sale, or
16 importation of any accused Minka product has not, does not, and will not
17 contributorily infringe any valid or enforceable claim of the '313 Patent;
- 18 5. A declaration that the manufacture, use, offer to sell, sale, or
19 importation of any accused Minka product has not, does not, and will not induce
20 infringement of any valid or enforceable claim of the '313 Patent;
- 21 6. A declaration that one or more claims of the '313 Patent are invalid;
- 22 7. A declaration that this case is exceptional under 35 U.S.C. § 285.
- 23 8. Awarding Minka its reasonable costs and attorneys' fees incurred in
24 defending this action pursuant to 35 U.S.C. § 285; and

25 ///

26 ///

27 ///

1 9. Awarding Minka such other and further relief as the Court deems just
2 and proper.

3
4 Dated: February 1, 2019

STREAM KIM HICKS WRAGE & ALFARO, PC

5
6
7 By: 

Theodore K. Stream
Mario H. Alfaro
Attorneys for Defendant
MINKA LIGHTING, INC.

8
9
10 **DEMAND FOR JURY TRIAL**

11 Defendant and Counter-Plaintiff Minka hereby demands a jury trial, as
12 provided by Rule 38(a) of the Federal Rules of Civil Procedure.

13
14 Dated: February 1, 2019

STREAM KIM HICKS WRAGE & ALFARO, PC

15
16
17 By: 

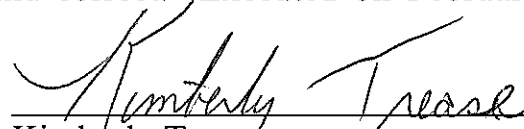
Theodore K. Stream
Mario H. Alfaro
Attorneys for Defendant
MINKA LIGHTING, INC.

Vaxcel International Co., Ltd vs. Minka Lighting, Inc.
USDC-Central District – Case No.: 5:18-cv-02549-GW-SHKx

CERTIFICATE OF SERVICE

I hereby certify that on February 1, 2019, I electronically filed the foregoing
**DEFENDANT MINKA LIGHTING INC.'S ANSWER AND
COUNTERCLAIM TO PLAINTIFF VAXCEL INTERNATIONAL CO.
LTD.'S COMPLAINT – DEMAND FOR JURY TRIAL** with the Clerk of the
Court using the CM/ECF system which will send notification of such filing to the
ECF registrants at the email addresses indicated on the attached Service List.

I certify under penalty of perjury under the laws of the United States of
America that the foregoing is true and correct. Executed on February 1, 2019,
Riverside, California.


Kimberly Trease
Stream Kim Hicks Wrage & Alfaro, PC
3403 Tenth Street, Ste. 700
Riverside, CA 92501
Telephone: (951) 783-9470
Facsimile: (951) 783-9475
Email: kimberly.trease@streamkim.com

Vaxcel International Co., Ltd vs. Minka Lighting, Inc.
USDC-Central District – Case No.: 5:18-cv-02549-GW-SHKx

SERVICE LIST

Electronic Mail Notice List:

Adriana Cara, Esq.
FISHER BROYLES, LLP
1902 Wright Place, Suite 200
Carlsbad, CA 92008
Telephone: (760) 918-5635
Facsimile: (760) 918-5638
Email: adriana.cara@fisherbroyles.com

Attorneys for Plaintiff,
**VAXCEL INTERNATIONAL
CO., LTD.**

Robert M. Halligan, Esq.
FISHER BROYLES, LLP
203 North La Salle Street, Suite 2100
Chicago, IL 60601
Telephone: (312) 607-0102
Email: rmarkhalligan@fischerbroyles.com

Attorneys for Plaintiff,
**VAXCEL INTERNATIONAL
CO., LTD.**